

Appln. No.: 09/626,954
Amdt. Dated January 27, 2004
Reply to Office Action dated November 10, 2003

Remarks/Arguments

1. **Status of Claims**

Claims 1-26 and 28-44 are pending in this application.

In the Office Action mailed November 10, 2003, claims 1-26 and 28-44 were rejected in view of references asserted under 35 USC §§102 and 103. Independent claims 15 and 19 have been amended. Applicant respectfully requests entry of the above amendments and consideration of the enclosed remarks. Applicant submits that no new matter is added.

2. **Rejection under 35 USC §102**

On page 3 of the Office Action mailed November 10, 2003, the Examiner rejected Claims 19 and 20 under 35 USC §102(b) as allegedly anticipated by U.S. Patent No. 5,612,889 to Pintsov, et al. ("Pintsov '889").

Applicant respectfully traverses the rejection. However, solely in order to expedite prosecution, Applicant has amended claim 19 to recite: and a postage indicium generated using said registration ID number and including data relating to said previously defined delivery address. The amendment is supported at least in the specification at paragraph 12.

Accordingly, Applicant respectfully submits that the rejection is moot and respectfully submits that claims 19 and 20 are patentable over the cited reference. Furthermore, Applicant reserves the right to pursue claims including those of the scope of original claim 19.

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The present invention is directed to a method of operating a postage metering system for printing postage indicia information on a business reply mail piece. This is particularly beneficial, because it enables business reply mail users to comply with United States Postal Regulations requiring that a delivery address and corresponding postage indicium be printed at the same time when printing postage from a computer-based postage metering system. This regulation ensures that there is a one-to-one correspondence between the delivery address and its associated postage indicium. In accordance with one aspect of this invention, the method of operating this system includes the steps of having a mail campaign sender transmit a registration ID number to a data center; the registration ID number being associated with a particular delivery address; generating and receiving postage indicium from the data center where the postage indicium information has been generated using the registration ID number and data relating to the delivery address; and printing the postage indicium information on an associated business reply mail piece for delivery to its intended designation.

There is absolutely no teaching or suggestion in Pintsov '889 of a business reply mail piece where the postage indicium appearing on the mail piece is generated using a registration ID number and data relating to the delivery address. Pintsov '889, in contrast, is directed to a system requiring a mailer to create a mailing list to be submitted to a carrier service for delivery. The mail carrier generates a unique mail piece identifier that is eventually printed on the mail piece with which it is associated. The mailer does not need to transmit this unique identifier to a data center to receive postage indicium information. The mailer simply places the identifier on a mail piece. These mail pieces with the unique identifiers are then submitted by the mailer to the

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carrier. From this unique identifier, the carrier is able to verify that data associated with the mail piece has been properly processed. These unique identifiers are separate and distinct from the postage indicium, and there is no suggestion or teaching in Pintsov '889 that the unique identifiers are used to generate postage indicium.

Claim 20 depends directly from independent claim 19 and is patentable over the cited reference for at least the same reasons.

Accordingly, Applicant respectfully submits that the rejection is moot and requests early and favorable consideration of the invention as presently claimed in claims 19 and 20. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection to claims 19 and 20.

3. Rejection under 35 USC §103(a)

On page 3 of the Office Action, the Examiner rejected claims 1-2, 4-5, 9-11, 15, 28, 34 and 36 under 35 USC §103(a) as allegedly rendered obvious by U.S. Patent No. 6,428,219 to Stier et al. ("Stier '219") in view of Pintsov '889.

Applicant respectfully traverses the rejection. Applicant submits that the references are not properly combined, and that the combination does not render the invention as presently claimed obvious. Further, the Examiner is improperly using hindsight and using the current claims as a roadmap to argue that the Applicant's claimed invention is obvious. However, solely in order to expedite prosecution, Applicant has amended claim 15 to recite: and where said registration ID number is used to generate a postage indicium.

Applicant submits that there is absolutely no suggestion in Stier '219 or Pintsov '889 of applying postage indicium to a business reply mail piece where the postage

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indicium is generated using a registration ID number and data relating to the delivery address. The Office Action contends that the system in Stier '219 teaches a method of operating a data center for generating postage indicium information for use with printing postage indicium on a business reply mail piece, where the postage metering system receives postage indicium information from the data center. Applicant respectfully disagrees. Nowhere in Stier '219 is there a disclosure, teaching or suggestion of having a data center transmit postage indicium information that is based on a registration ID number or a delivery address to a postage metering system to be applied to an associated business reply mail piece, the same mail piece that was used to generate the registration ID number.

The Examiner's reference to Pintsov '889 does not cure the deficiencies of Stier '219. The Office Action contends that Pintsov '889 teaches a mail processing system where the generated registration ID corresponding to the delivery address previously defined by the mail campaign sender is transmitted to the data center and concludes that it would have been obvious to generate postage indicium information using the registration ID number, as taught by Pintsov. Applicant respectfully disagrees with the Examiner's characterization of the teachings of Pintsov '889. Applicant submits that the Examiner has misconstrued the teachings of Pintsov '889, and that the elements identified by the Examiner are not supported by the Specification.

As discussed above, Pintsov '889 is directed to printing a unique identifier onto a mail piece to verify data associated with a mail piece. Nowhere in Pintsov '889 is there a suggestion or teaching that this unique identifier is in any way associated with or used to generate the postage indicium that is placed on a mail piece.

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Applicant respectfully submits that these cited references do not render the invention as presently claimed obvious and are not properly combined. Accordingly, Applicant respectfully submits that the Examiner has not established a prima facie case of obviousness.

Claims 2, 5, 10, 11, 28, 34 and 36 depend directly or indirectly from the respective independent claims and are patentable over the cited references for at least the same reasons.

Applicant respectfully submits that the invention as claimed is patentable over the Stier '219 and Pintsov '889 references. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.

In section 4 of the Office Action, the Examiner rejected claims 3, 6, 12, 16, 22, 25, 30-31, 39-40, and 42 under 35 USC §103(a) as allegedly being rendered obvious by Stier '219 and Pintsov '889, and further in view of U.S. Patent No. 6,526,393 to Fredman ("Fredman '393").

Applicant respectfully traverses the rejection for at least the reasons stated above with regard to Stier '219 and Pintsov '889 in responding to the 35 USC §103(a) rejection in section 3 of the Office Action. Claims 3 and 22 depend directly and indirectly upon Claim 1 and are patentable along with Claim 1 over the cited references for at least the reasons stated above and on their own merits. Claims 6, 25, 30-31 and 39-40 depend directly and indirectly upon Claim 4 and are patentable along with Claim 4 over the cited references for at least the reasons stated above and on their own merits. Claims 12 and 42 depend directly and indirectly upon Claim 9 and are patentable along with Claim 9 over the cited references for at least the reasons stated

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above and on their own merits. Claim 16 depends directly upon Claim 15 and is patentable along with Claim 15 over the cited references for at least the reasons stated above and on their own merits.

Furthermore, the Examiner's reliance on Fredman '393 does not cure the deficiencies of Stier '219 and Pintsov '889. Fredman '393 is directed to a time-controlled, pre-paid delivery system where date sensitive postage is pre-printed on the envelope by the issuer. There is absolutely no teaching or suggestion in Fredman '393 of at least associating a registration ID number with a previously defined delivery address; transmitting the registration ID number to a data center; generating the postal indicia information using the registration ID number; transmitting the postage indicium information to a postage metering system; and printing the postage indicium information on an associated business reply mail piece.

Accordingly, Applicant submits that for at least the reasons stated above, the cited references do not alone or in proper combination render obvious the invention as presently claimed in claims 3, 6, 12, 16, 22, 25, 30-31, 39-40, and 42. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.

In section 5 of the Office Action, the Examiner rejected claims 7-8, 13-14, 17-18, 21, 23-24, 26, 32-33, 35, 37-38, 41, and 43-44 under 35 USC §103(a) as allegedly being rendered obvious by Stier '219, Pintsov '889, Fredman '393, and further in view of U.S. Patent No. 6,121,565 to Allott, III ("Allott '565").

Applicant respectfully traverses the rejection for at least the reasons stated above with regard to Stier '219, Pintsov '889 and Fredman '393 in responding to sections 3 and 4 of the Office Action. Claims 21, 23 and 24 depend directly and

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indirectly upon Claim 1 and are patentable along with Claim 1 over the cited references for at least the reasons stated above and on their own merits. Claims 7-8, 26 and 41 depend directly and indirectly upon Claim 4 and are patentable along with Claim 4 over the cited references for at least the reasons stated above and on their own merits. Claims 13-14, 32-33 and 43-44 depend directly or indirectly upon Claim 9 and are patentable along with claim 9 over the cited references for at least the reasons stated above and on their own merits. Claims 17-18, 35, 37 and 38 depend directly and indirectly upon claim 15 and are patentable along with Claim 15 over the cited references for at least the reasons stated above and on their own merits.

Furthermore, there is no teaching or suggestion in Allott '565 of using expiring indicia in a postage metering system where a registration ID number is associated with a previously defined address; the registration ID number is transmitted to a data center; the postal indicia information is generated using the registration ID number and delivery address information and transmitted to a postage metering system; and printing the postage indicium on an associated business reply mail piece.

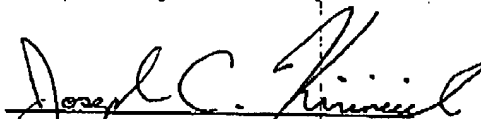
Accordingly, Applicant submits that for at least the reasons stated above, the cited references do not alone or in proper combination render obvious the invention as presently claimed in claims 7-8, 13-14, 17-18, 21, 23-24, 26, 32-33, 35, 37-38, 41, and 43-44. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.

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4. Conclusion:

In view of the foregoing amendments and remarks, it is respectfully submitted that the claims of this application are in condition for allowance, and favorable action thereon is requested. If the Examiner finds reason not to allow all claims, then Applicant again respectfully requests a telephone interview with the Attorney signed below.

Respectfully submitted,



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